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TO: USPTO

DATE: December 1, 2005

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RE: **Response to Office Action**

Serial Number: 10/807,023

Confirmation Number: 2248

Filing Date: 3/23/2004

First Inventor: CHEN, S., et. al.

Attorney Docket Number: 9/279

Philip I. Datlow
Telephone (203) 798-4542
Telefax (203) 798-4408
E-Mail pdatalog@rdg.boehringer-ingelheim.com

900 Ridgebury Rd/P.O. Box 368
Ridgefield, CT 06877-0368

Dear Sir:

Please find transmitted herewith a Response to the Office Action dated November 1, 2005 for the above-identified application.

The Commissioner is hereby authorized to charge or credit any fee which may be required to Deposit Account No. 02-2955.

Respectfully Submitted,

Philip I. Datlow
Reg. No. 41,482

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Philip I. Datlow, Reg. No. 41,482

RESPONSE
US APPLN. NO. 10/807,023

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of: CHEN, S., et. al.) Art Unit: 1654
Serial No.: 10/807,023) Examiner: Kosar, Andrew D.
Conf. No.: 2248
Filed: 03/23/2004
For: Pharmaceutical Compositions for Hepatitis C Viral Protease Inhibitors
Dcket No.: 9/279

Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

RESPONSE

Sir:

This is in response to the Office Action dated November 1, 2005, setting forth a 1 month period for reply. At page 2 of the office action, the examiner sets forth a restriction requirement in 4 groups:

- I. Claims 1-27, drawn to a composition comprising compounds of formula (I)
- II. Claim 28, drawn to a method of manufacturing a composition of claim 1
- III. Claim 29, drawn to a method of inhibiting HCV replication
- IV. Claim 30, drawn to treating HCV infection in a mammal

At pages 3-4, the examiner also requires an election of species with respect to the pharmaceutical composition, i.e. a single pharmaceutical composition where each element (a) to (g) is fully defined, and any claims readable thereon.

In response, Applicants herein elect Group I, with Formulation #3 (at page 39) as the elected species. Claims 1-13 and 15-30 read upon this elected species, or its method of use or method of synthesis. This election is made with traverse.

Applicants traverse the election of species requirement. Applicants submit that, at the very least, the compounds of formula (I) as depicted in claim 1 constitute a proper Markush Group of compounds as they all share a common substantial structural core and all share a common utility as HCV NS3 protease inhibitors useful for treating HCV infection. In addition, all the claimed

RESPONSE
US APPLN. NO. 10/807,023

pharmaceutical compositions are related by being compositions of the compounds of formula (I) and having the components in the amounts indicated in claim 1. All the compositions contain an amine or mixture of amines in amounts indicated, a base or mixture of bases in amounts indicated and one or more oils, as specified for components (b) to (d), and all optionally contain one or more solvents, polymers and/or surfactants as specified for components (e) to (g). Thus, Applicants respectfully submit that the claimed subject matter is sufficiently related to be properly presented and examined in a single application. Accordingly, Applicants elect a single disclosed composition species herein on the understanding that this is done only to facilitate initial search and examination, but that this application will be generically examined in accordance with the USPTO's Markush Practice as outline in MPEP 803.02 in the event that the elected species is found to be patentable.

Applicants appreciate the Examiner's acknowledgment (at pgs. 4-5 of the Office Action) that the USPTO's Rejoinder Practice (MPEP 821.04) is applicable to the present application. In the event that the product claims of Group I are found to be allowable, Applicants request that the process (method) claims of Groups II, III and IV be rejoined in the examination under Rejoinder Practice since all these process claims depend from the product claims of Group I.


In view of the above remarks, Applicants respectfully submit that this application is now in condition for early examination. If any points remain at issue which can best be resolved by way of a telephonic or personal interview, the Examiner is kindly requested to contact the undersigned attorney at the telephone number listed below.

Respectfully submitted,



Philip I. Datlow
Attorney for Applicant(s)
Reg. No. 41,482

Patent Department
Boehringer Ingelheim Corp.
900 Ridgebury Road
P.O. Box 368
Ridgefield, CT 06877
Tel: (203) 798-4542
Date: December 1, 2005

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